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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,137	12/15/2003	Thomas E. Creamer	BOC9-2003-0093 (464)	3692
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AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			EXAMINER AHMED, SALMAN	
			ART UNIT	PAPER NUMBER
			2619	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/736,137	Applicant(s) CREAMER ET AL.	
	Examiner SALMAN AHMED	Art Unit 2619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/12/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/15/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-21 are pending.

Claims 1-21 are rejected.

Response to Arguments

4. Applicant's arguments see pages 7-11 of the Remarks section, filed 2/12/2008, and pages 7-8 of the Remarks section, filed 3/12/2008, with respect to the rejections of the claims have been fully considered and are not persuasive.

35 USC 103 rejection of claims 1-21:

The Affidavit filed on 2/12/2008 under 37 CFR 1.131 has been considered but is ineffective to overcome the Hicks reference.

Applicant argues that (see page 7, paragraph 4 of the Remarks section, filed 2/12/2008) the claimed invention was conceived prior to June 6 2003 (see 37 CFR 1.131 affidavit filed on 2/12/2008). In addition to submitting Declarations, Applicant has submitted the followings as supporting documents:

Exhibit A is an email letter, dated September 25, 2003, from Inventor Tom Creamer to IBM in-house counsel with comments regarding search results.

Exhibit B is a letter from an IBM Patent Attorney requesting outside counsel prepare the Application, dated September 25, 2003.

Exhibit C is a letter from outside counsel confirming receipt of the instructions, dated October 2, 2003.

Exhibit D is an email letter from outside counsel requesting review and approval of the Application drafted by outside counsel, dated November 29, 2003.

Exhibit E is an email letter from Inventor Neil Katz, approving the draft Application, dated November 30, 2003.

Exhibit F is an email letter, dated December 1, 2003, from outside counsel requesting review and final approval of the Application, together with Declaration and Power of Attorney and Assignment for the inventors to sign.

Exhibit G is a copy of the Declaration and Power of Attorney signed by the inventors and filed with the Application on December 15, 2003, evidencing the inventors' approval of the application.

However, Examiner respectfully submits that the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Hicks reference to either a constructive reduction to practice or an actual reduction to practice. Applicant's submitted Exhibits A is an email letter, dated September 25, 2003, from Inventor Tom Creamer to IBM in-house counsel with comments regarding search results. However, no supporting document has been produced to show due diligence from the date prior to June 6, 2003 (Hicks reference earliest effective filing date) to the Exhibit A email date of September 25, 2003 related to the instant Application. The affidavit must explain how the documents and other evidence establish the facts which are being offered to prove conception, diligence and/or a reduction to practice of the claimed invention. See *In re Borkowski*, 505 F.3d 713, 719, 184 USPQ

29, 33 (CCPA 1974). Conception, diligence, and an actual reduction to practice are legal conclusions. The Rule 131 Affidavit or declaration must supply sufficient facts to support those conclusions, *In re Clarke*, 356 F.2d 987, 993, 148 USPQ 665, 671 (CCPA 1966).

As such Examiner respectfully disagrees with the Applicant's assertion that Hicks is not a valid prior art reference and Examiner further respectfully disagrees with the Applicant's assertion that Hicks cannot be used to render obvious the embodiments of Applicant's present invention as claimed in claims 1-21.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks III (US PAT PUB 2006/0019667) in view of Virtanen et al. (US PAT PUB 2002/0006797, hereinafter Virtanen).

In regards to claims 1, 8 and 15 Hicks teaches a method/means of roaming between mobile and wireless networks comprising: detecting a wireless network in proximity to a mobile device (section 0101, the wireless access point 512 detects the dual mode telephone 106 entering the wireless network from the MAC broadcast by the dual mode telephone 106); querying the wireless network for an Internet Protocol address for the mobile device (section 0101, at block 808, the MAC address is obtained from the broadcast and an IP address is assigned to the handset having the MAC address. Depending upon the connectivity of the wireless access point to the wired data network, the IP address may be assigned at a local router or may be assigned at a remote router of the wired data network); receiving the Internet Protocol address (section 0101, at block 808, the MAC address is obtained from the broadcast and an IP address is assigned to the handset having the MAC address. Depending upon the connectivity of the wireless access point to the wired data network, the IP address may be assigned at a local router or may be assigned at a remote router of the wired data network); and sending a message via a mobile network for the mobile device to a mobile switching center of the mobile network (section 0104, at block 820, the dual mode telephone 106 sends a first message such as, for example, a short message service (SMS) message to the MSC 272 of the licensed wireless network 112 notifying the MSC 272 to route communications directed to the wireless number associated with

the dual mode phone 106 to the wired data line number associated with the phone 106), wherein the message instructs the mobile switching center to route voice data intended for the mobile device to the Internet Protocol address via a communicatively linked gateway and the wireless network (section 0104, At block 824, when a communication directed to the wireless number associated with the dual mode phone 106 is received at the MSC 272, a termination attempt trigger is generated at the MSC. In response thereto, a query is transmitted to the HSS 912 requesting further instructions on the handling of the incoming communication at block 826. Based on the content of the first message stored at the HSS 912, at block 828 the incoming communication is routed to the wired data line number associated with the dual mode phone 106 via the unlicensed wireless network 110 for VoIP communication, such as through the GMSC 250 and MGW 246 from the MSC 272).

In regards to claims 5, 7, 12, 14, 19 and 21 Hicks teaches method/means for communicating over a wireless network using a mobile device (section 0104, the user may send and receive subsequent calls on the dual mode telephone 106 via the cordless mode through the unlicensed wireless network 110), detecting that the mobile device is roaming outside a coverage area of the wireless network (section 0105, at block 834, the dual mode telephone 106 detects the loss of the unlicensed wireless network connectivity); and sending a message via a mobile network for the mobile device to a mobile switching center of the mobile network (section 0105, accordingly, the dual mode phone 106 sends a second message to the MSC 272 of the licensed wireless network 112 notifying the MSC 272 to route communications directed to the

wireless number associated with the dual mode phone 106 to the wireless number at block 836), wherein the message instructs the mobile switching center to route voice data intended for the mobile device to the mobile device using at least one mobile voice channel of the mobile network (section 0105, when a communication directed to the wireless number associated with the dual mode phone 106 is received at the MSC 272, a termination attempt trigger is generated at the MSC 272. In response thereto, a query is transmitted to the HSS 912 requesting further instructions on the handling of the incoming communication. Based on the content of the second message stored at the HSS 912, the incoming communication is routed to the wireless number associated with the dual mode phone 106 via the licensed wireless network 112 for wireless (mobile) communication).

Hicks does not explicitly teach message being send via control channel.

Virtanen in the same field of endeavor teaches message being send via control channel (section 0069, if, in step 901, the MS finds out that a call is going on, it delivers in step 911 the SM via control channels related to that call).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hicks' system/method by incorporating the steps of message being sent via control channel as suggested by Virtanen. The motivation is that, by utilizing the less used control channel for transmitting messages, a system can efficiently utilize available bandwidth; thus making more efficient usage of network resources.

In regards to claims 5, 7, 12, 14, 19 and 21 Hicks and Virtanen do not explicitly teach transmitting voice using voice channel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hicks and Virtanen's system/method by incorporating the steps of transmitting voice using voice channel, as voice channels are designated in a wireless network to efficiently and reliably transmit voice signals for implementing successful voice communication.

In regards to claims 15 and 19 Hicks teaches a machine readable storage, having stored thereon a computer program having a plurality of code sections executable by a machine (Figure 2, digital cordless telephone or handset 104 has memory, processor/controller/dsp and program associated with it).

In regards to claims 2, 9 and 16 Hicks teaches receiving voice data from the gateway via the wireless network (section 0104).

In regards to claims 3, 10 and 17 Hicks teaches configuring the mobile switching center to route voice data intended for the mobile device to the Internet Protocol address via the communicatively linked gateway and the wireless network (section 0104).

In regards to claims 4, 11 and 18 Hicks teaches prior to detecting step, the mobile device is in communication with a different wireless network (section 0100).

In regards to claims 6, 13 and 20 Hicks teaches receiving voice data from the mobile switching center via the mobile network (section 0105).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SALMAN AHMED whose telephone number is (571)272-8307. The examiner can normally be reached on 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached on (571) 272-7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Salman Ahmed/
Examiner, Art Unit 2619